

then passed into the borehole, and after using up the assembled pipe length a second ground-assembled pipe length is welded to the end of the first pipe length 12, and the operation is continued. Thus, Priestman et al. connects the second pipe length to the first pipe length after the first pipe length has been brought in communication with the borehole. Claim 1 is therefore novel over Priestman et al. and reconsideration and allowance of claim 1 is respectfully requested.

Claims 4-7 all depend from claim 1 and therefore claim that "said connection of successive tube parts end-to-end into said tube is completed before said tube is brought in communication with the borehole". Because Priestman et al. does not disclose this element, each of claims 4-7 is novel over Priestman et al. and reconsideration and allowance of claims 4-7 is respectfully requested.

Claim 9 is also novel. Claim 9 claims "said connecting area being located at least horizontally spaced away from the borehole". Priestman et al., in contrast, discloses (col. 4, lines 11-19) that after one length of pipe has been used up, the end of the pipe 12 may be uncoupled from pipe 31 and a new reel of pipe substituted for reel 18 and the end thereof joined to pipe 12 as by welding or otherwise. There is no disclosure in Priestman et al. that the connecting area is located horizontally spaced away from the borehole. Claim 9 is therefore novel over Priestman and reconsideration and allowance of claim 9 is respectfully requested.

Claims 10, 11, 12 and 14 all depend from claim 9 and therefore also claim "said connecting area being located at least horizontally spaced away from the borehole". Because there is no disclosure in Priestman et al. that the connecting area is located horizontally spaced away from the borehole, claims 10, 11, 12 and 14 are all novel over Priestman et al. Reconsideration and allowance of claims 10, 11, 12 and 14 is respectfully requested.

Response to Claim Rejections Under 35 U.S.C. § 103

Claims 2-3

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as unpatentable over Priestman et al. and Tesson, ('461). However, claims 2 and 3 both depend on claim 1 and therefore both claim that "the connection of successive tube parts end-to-end into said tube is

completed before said tube is brought in communication with the borehole". Neither Priestman et al. nor Tesson discloses or suggests this feature. A person skilled in the art would not arrive at the subject matter of claims 2 and 3 by combining Priestman et al. and Tesson. Claims 2 and 3 are therefore not obvious and reconsideration and allowance of claims 2 and 3 is respectfully requested.

Claim 8

Claim 8 was rejected under 35 U.S.C. § 103(a) as unpatentable over Priestman et al. because it would be obvious to modify Sizer ('345) to have the maximum total deformation during the bending into a curved shape to be less than 2%. However, claim 8 depends from claim 1 and therefore claims that "the connection of successive tube parts end-to-end into said tube is completed before said tube is brought in communication with the borehole". Neither Priestman et al. nor Sizer discloses or suggests this feature. A person skilled in the art would not arrive at the subject matter of claim 8 by combining Priestman et al. and Sizer, or by modifying Sizer. Therefore, claim 8 is not obvious and reconsideration and allowance of claim 8 is respectfully requested.

Claim 13

Claim 13 was rejected under 35 U.S.C. § 103(a) as unpatentable over Priestman et al. in view of Krall ('471). Claim 13 depends from claim 12 and therefore claims "said connecting area being located at least horizontally spaced away from the borehole". Neither Priestman et al. nor Krall disclose this feature and a person skilled in the art would not arrive at the subject matter of claim 13 by combining Priestman et al. and Krall. Therefore, claim 13 is not obvious and reconsideration and allowance of claim 13 is respectfully requested.

Claims 15 and 29

Claims 15 and 29 were rejected under 35 U.S.C. § 103(a) as unpatentable over Priestman et al. in view of 'Arc Welding Safety' by Fluegel et al. However, claim 15 depends from claim 12 and therefore claims "said connecting area being located at least horizontally

spaced away from the borehole”. Neither Priestman et al. nor Fluegel discloses this feature, and a person skilled in the art would not arrive at the subject matter of claim 15 by modifying Priestman et al. as taught by Fluegel. Claim 15 is therefore not obvious and reconsideration and allowance of claim 15 is respectfully requested.

Claim 29 depends from claim 19 and therefore claims “said connecting area being located at least horizontally spaced away from said well head”. Neither Priestman et al. nor Fluegel discloses this feature. Therefore, claim 29 is not obvious because a person skilled in the art would not arrive at the subject matter of claim 29 by modifying Priestman et al. as taught by Fluegel. Reconsideration and allowance of claim 29 is respectfully requested.

Claims 16-17

Claims 16 and 17 were rejected under 35 U.S.C. § 103(a) as unpatentable over Priestman et al. in view of Sizer (‘345). The Office Action states that it is obvious to one skilled in the art to modify Priestman et al. to include disconnecting the tube parts in the connecting area in order to store the tube parts, which is taught by Sizer. However, in order to establish that an invention is obvious in light of a combination of the prior art, there must be some teaching, suggestion or motivation to combine or modify the teachings of the prior art. Also, an invention is not obvious in light of a combination of prior art references if the proposed modification of a reference changes the principle of operation of the reference. M.P.E.P. 2143.01. For both of these reasons, claims 16 and 17 are not obvious in light of Priestman et al. and Sizer.

First, there is no such teaching, suggestion or motivation to combine Priestman et al. and Sizer. Claim 16 claims “that portions of said tube or said composed section thereof proceeding along said curved path are bent into at most one single curve” while claim 17 claims “that portions of said tube or said composed section thereof is bent to a curved shape in exclusively one direction relative to that portion of said tube.” While the method disclosed by Priestman et al. (Fig. 1) has a tube part that proceeds along a curved path with a single curve at most, the tube part disclosed by Sizer is markedly different because it proceeds along a curved path with two opposite curves. The teaching of Sizer to disconnect tube parts is premised on the fact that the tube of Sizer is composed of an elongate string of pipe joints that flex around

multiple curves, so that the tube sections are preferably small and disconnectable from one another. This teaching would not have been obvious to apply to a tube as is taught by Priestman et al., which is continuous and is only bent with a single curve at most. There is no motivation for disconnecting tube parts from one another in the manner taught for the multi-curved tube of Sizer when only a single-curved tube is used, as taught by Priestman et al. Because the requisite suggestion or motivation to combine the teachings of Priestman et al. and Sizer is lacking, it would not have been obvious to a person skilled in the art to combine the method of Priestman et al. with the method of Sizer to arrive at the subject matter of claim 16 or claim 17. Thus, reconsideration and allowance of claims 16 and 17 is respectfully requested.

In addition, modifying Priestman et al. to include disconnecting the tube parts in the connecting area in order to store the tube parts would change the principle of operation of the method taught by Priestman et al. Priestman et al. teaches a system where a continuous pipe is bent into a curved shape. Disconnecting parts of tubes from each other, as taught by Sizer, would change the principle of operation of the method of Priestman et al., which is to form a single-curve shape by bending a continuous piece of pipe. Because modifying Priestman et al. to include disconnecting tube parts in the connecting area in order to store the tube parts would change the principle of operation of the method taught by Priestman et al., claims 16 and 17 are not obvious and reconsideration and allowance of claims 16 and 17 is respectfully requested.

Claims 18-28

Claims 18-28 were rejected as unpatentable over Priestman et al. in view of 'Arc Welding Safety' by Fluegel et al. and Pringle et al. ('951). However, claims 18 and 19 both claim "a connection structure for composing the tube by connecting successive tube parts end-to-end in a connecting area" and both claim "said connecting area being located at least horizontally spaced away from the wellhead". Neither Priestman et al. nor Pringle et al. disclose either of these features, so claims 18 and 19 would not be obvious to a person skilled in the art. Reconsideration and allowance of claims 18 and 19 is respectfully requested.

Claims 20-28 depend on claim 19 and therefore each claim "a connection structure for composing the tube by connecting successive tube parts end-to-end in a connecting

area” and “said connecting area being located at least horizontally spaced away from the wellhead”. Neither Priestman et al. nor Pringle et al. disclose either of these features, so a person skilled in the art would not arrive at the subject matter of claims 20-28 by modifying Priestman et al. as taught by Pringle et al. Therefore, reconsideration and allowance of claims 20-28 is respectfully requested.


Conclusion

Applicant believes that this Response places the application containing claims 1-29 in condition for allowance. Reconsideration and notice to that effect are respectfully requested. The Examiner is invited to contact the undersigned attorney at the number listed below if such a call would in any way facilitate allowance of the application.

Respectfully submitted,

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